

# Browne & Woods LLP

## MEMORANDUM

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### STATE BAR OF CALIFORNIA INTELLECTUAL PROPERTY SECTION TRADE SECRET COMMITTEE

#### *January 18, 2005 Meeting Minutes*

The Trade Secrets Committee held a telephonic meeting on January 18, 2005.

The following are the minutes of that meeting

1. **Attendance.** The following Committee members attended the meeting: Ben Scheibe, Joanna Mendoza, Bec Edelsen, Randy Kay, Jennifer Brockett, Jim Pooley, Bryan Walton, and Bart Smith.

2. **Update On Trade Secrets Treatise.** Randy Kay updated Committee members on the progress of the trade secret treatise that was edited by and written by members of the Committee. It is anticipated that the treatise will be promoted again at the April 2005 In-House Counsel program in San Jose and published through the State Bar later this year.

3. **Upcoming programs.** The members discussed upcoming programs, which included:

a. **April 2005** – Ben Scheibe will be speaking at the In-House Counsel program, to be held in April in San Jose.

b. **February 10, 2005 program to be rescheduled:** A lunch program developed by Bec entitled “*Protecting Your Business From Departing Employees*” had been

scheduled for February 10, 2005, to be held at Alschuler Grossman Stein & Kahan. The program, however, is being rescheduled for a later date. Committee members will receive notice of the new date from the State Bar and it is believed that telephonic access also will be provided.

- c. **November 2005:** The Committee will be developing two programs for the IP Institute in Napa. One will likely be a “year in review” or “recent developments” type program and the other will be more of a panel discussion on as-yet undetermined topics. Ben Scheibe is heading this effort up. Committee members who have ideas for topics and/or speakers should contact Ben.

4. **Speaking Opportunities/Writing Opportunities.** The Committee members discussed the need for the Committee to keep a flow of articles to *New Matter*. John Yates and Ben Scheibe have articles in progress. Members interested in writing an article (from 1500 to 6000 words) should e-mail Ben or the editors of *New Matter* (with a copy to Ben) with a proposed topic and target date so as to reserve the topic with *New Matter*. The articles need not be in depth, law review type articles, and can cover narrow topics that may be of interest to members of the IP Section. Members are encouraged to take briefs or research memoranda from their practice and turn these into articles if the topics are of interest to the trade secret or IP community.

5. **Case Law Discussion.** John Yates briefed the Committee and conducted a discussion on the recent case of *Koresko v. Bleiweis*, decided by a federal district court in Pennsylvania.

6. **Plain English Trade Secret Jury Instruction Project.** As mentioned in prior minutes, a subcommittee has been established, consisting of Ben Scheibe, Carolyn Sieve, Randy Kay, Marshall Lerner, Bec Edelson, and Robert Freitas. Robert Freitas has volunteered to head the Committee and to act as a clearinghouse to collect instructions from Committee members. Although Robert has received a few instructions, he has asked for additional

instructions from Committee members. All Committee members are encouraged to provide trade secret instructions they have found useful in the past to Robert Freitas:

[RFreitas@Orrick.com](mailto:RFreitas@Orrick.com)

**7. New Project(s).**

- a. Website:** The “Frequently Asked Questions” page on our Committee’s website is somewhat out of date. Committee members are asked to review the page with an eye towards updating the pages and making them more user friendly. Vice Chair David Morales is heading up this project. Although David has heard from one or two volunteers, additional volunteers would be helpful. Volunteers should e-mail David ([dmorales@lqpatlaw.com](mailto:dmorales@lqpatlaw.com)) and suggestions for website improvements can be e-mailed to David as well or submitted at the next meeting. Our current pages may be viewed at:

[http://www.calbar.ca.gov/state/calbar/calbar\\_sections\\_generic.jsp?sImagePath=Intellectual-Property-Section\\_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP\\_Cmte\\_Secrets\\_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP\\_Cmte\\_Home-Page.html&sCatHtmlPath=html/IP\\_Cmte\\_Secrets\\_Home.html](http://www.calbar.ca.gov/state/calbar/calbar_sections_generic.jsp?sImagePath=Intellectual-Property-Section_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP_Cmte_Secrets_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP_Cmte_Home-Page.html&sCatHtmlPath=html/IP_Cmte_Secrets_Home.html)

- b. CLE By Phone:** The members further discussed the idea of the Committee hosting telephonic CLE programs on trade secret related topics. The programs would be one hour; participants would participate by phone and receive CLE credit through the State Bar. There seems to be sufficient interest among committee members and Committee members were asked to think about potential topics and speakers. In the meantime, we understand that the

Trademark Committee recently held such a “teleseminar” and our committee is interested in learning from its experience.

- c. **Legislative Reform:** Interest was expressed in possibly proposing legislative reform on issues of interest to trade secret practitioners. One such issue is the possible abuse of the litigation process by asserting spurious claims of trade secrets in order to obtain access to a competitor’s confidential information. Another area of interest among Committee members is California’s departure from the “readily ascertainable” language of the Uniform Trade Secrets Act. Joanna Mendoza has circulated a draft identifying the issue and a possible remedy through the amendment of CCP § 2019(d), and Jim Pooley has expressed interest in this project as well. An ad hoc sub-committee was formed to discuss ideas.

8. **Next Meeting.** The Trade Secret Committee will have its next telephonic meeting on March 15, 2005 at 3:00 p.m. Ben will circulate call-in information in advance of the meeting.